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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 428

COLUMBIA BOILER CO., INC., *Petitioner*,

v.

MANVILLE BOILER CO., INC., *Respondent*.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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Petitioner, the defendant-appellee below, respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fourth Circuit entered in the above-entitled action on July 25, 1959.

OPINIONS BELOW

The opinion of the Court of Appeals for the Fourth Circuit is reported at 122 USPQ 545 and appears as Appendix A to this Petition. The District Court did not hand down an opinion, but made findings of fact and conclusions of law, which appear as Appendix B to this Petition.

JURISDICTION

The judgment of the Court of Appeals was entered on July 25, 1959. The jurisdiction of this Court is invoked under 28 U. S. C. Sec. 1254(1).

QUESTIONS PRESENTED

(1) Was it not error, in view of the express condition of the Patent Act of 1952 that a patent may *not* be obtained if the differences between the alleged invention and the prior art are such that the subject matter as a whole *would be obvious* to a person having ordinary skill in the art, for the Court below to adopt a more liberal standard of invention than that established by decisions of this Court prior to that Act?

(2) Was it not error for the Court below, in conflict with the rulings of various other Circuits, to apply more liberal rules as to invention than those established by decisions of this Court prior to the Patent Act of 1952?

STATUTE INVOLVED

Section 103 of the Patent Act of 1952, 66 Stat. 792-814, 35 U. S. C. Sec. 1-293, which is involved here, is printed in Appendix C to this Petition.

STATEMENT OF THE CASE

Respondent brought this suit against petitioner for infringement of U. S. Patent No. 2,633,107 issued March 31, 1953 to B. W. Mandelburg (see Plaintiff-Appellant's Appendix, p. 82).

The subject matter of the alleged invention had to do with the substitution of a round rather than oval smoke outlet or flue on a domestic hot water heating boiler.

Obviously, there was nothing either new or inventive about a round outlet pipe, but in the particular type of boiler involved petitioner had used an oval smoke outlet and the substitution of a round outlet required some internal rearrangement of the boiler construction.[1]

There was substantial undisputed testimony that there were a number of simple ways available to accommodate the round outlet pipe.[2] The one used by petitioner was adopted by a welding foreman,[3] who simply used an arrangement similar to what petitioner had used for many years in other types of boilers.[4]

District Judge Hutcheson held the claim in suit fully anticipated by these other boilers, also invalid over prior art, and finally not infringed (see Plaintiff-Appellant's Appendix, pp. 120-123). The Court of Appeals, without express reference to these findings, took a diametrically opposite view and held the claim in suit both valid and infringed.

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[1] The best that the Court of Appeals could say was that this change was "desirable" to avoid "difficulty and expense" in the installation of boilers with oval outlets, but their avoidance could not be "classified as a major contribution to the heating industry" (Appendix A, p. 5a). The fact was that any gain from the avoidance of these minor disadvantages was more than offset by the increased danger of pressure drop (Appellee's Appendix, pp. 38a-39a) and petitioner was reluctant to make the change for this reason.

[2] For testimony to this effect, see Plaintiff-Appellant's Appendix, pp. 58, 98-100, 102.

[3] Plaintiff-Appellant's Appendix, p. 69.

[4] Defendant-Appellee's Appendix, pp. 31-33.

REASONS FOR GRANTING THE WRIT

(1) The Decision of the Court of Appeals Is Based on a Standard of Invention Derived From an Interpretation of the Patent Act of 1952 Which This Court Has Not Sanctioned and Which Conflicts With Prior Decisions of This Court.

Ever since the Patent Act of 1952 was enacted, there has been uncertainty and confusion in judicial decisions and professional opinions as to the effect of Section 103, or as to the lack of it, on the strict standard of invention established by the decisions of this Court prior to the Act. There has been no occasion for this Court to speak on the interpretation of the Section, or as to the standard of invention, since the Act was passed, and nothing less than an authoritative interpretation by this Court will resolve the doubt and restore much needed stability.

Indicative of the urgency of the need is the fact that at least two other petitions involving this question are currently pending before the Court as this is written. In *Bernard Glagovsky* v. *Bowcraft Trimming Co. et al.*, No. 369, this Court is asked to review a decision of the First Circuit Court of Appeals which is to the diametrically opposite effect from the decision of the Fourth Circuit Court of Appeals referred to above. In *Stoffel Seals Corporation* v. *E. J. Brooks Company*, No. 361, the majority opinion of the Second Circuit Court of Appeals was in line with that of the First Circuit in the Glagovsky case; the dissenting opinion was in line with that of the Fourth Circuit in the present case.

The Applicable Standard of Invention Prior to 1952

In *Hotchkiss* v. *Greenwood*, 52 U. S. 248, 266-267 (1851), this Court set forth the requirement for patent-

ability that there must be a result of ingenuity and skill more than that "possessed by an ordinary mechanic acquainted with the business". Almost the same language is used in the Patent Act of 1952—a patent may not be granted for subject matter that would have been obvious "to a person having ordinary skill in the art".

The above language has had different meanings at different times. Two of the latest interpretations by this Court are found in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84 (1941) and *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950). In the *Cuno case*, the Court summarized the cases beginning with *Hotchkiss* v. *Greenwood* as meaning that the new device must "reveal the flash of creative genius, not merely the skill of the calling". Ingenuity is not enough; there must be something "more than that to be expected of a mechanic skilled in the art". In the later *A. & P. case*, the lower Courts were admonished to "scrutinize combination patent claims with care" to make sure they meet the "rather severe test" of producing "unusual or surprising consequences from the unification of the elements" concerned.

Judged by the above tests, the decision of the Fourth Circuit Court of Appeals is plainly defective in that "a standard of invention appears to have been used that is less exacting than that required where a combination is made up entirely of old components" (*A. & P. case*, *supra*, p. 154).

The 1952 Act Did Not Change the Standard of Invention

Until the decision of the Second Circuit Court of Appeals in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530 (1955), there was general agreement that the Act of 1952 merely codified the existing decisional law as to standard of invention.[1] The standard of the *Cuno* and *A. & P. cases* continued to be applied.

Beginning with the *Lyon case* in 1955, however, the view has gained acceptance that Section 103, although essentially the same in language as *Hotchkiss* v. *Greenwood*, was nevertheless intended to and did destroy the standard of invention as developed through the *Cuno* and *A. & P. cases* and to require a "return" to some less strict standard not yet defined by this Court.[2] The Fourth Circuit Court of Appeals has followed suit, referring in *Brown et al.* v. *Brock et al.*, 240 F. 2d 723, to the "accepted tests" of the standard of invention "as recently explained in *Lyon* v. *Bausch & Lomb*".

But even Judge Learned Hand was not sure of his position in the *Lyon case*. As he later said before a Senate committee, it "remains to be seen" whether the Court was right and "I hope the case will go up".[3]

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[1] H.R. Rep. No. 1923, 82nd Cong., 2d Sess., p. 7, stated expressly that Section 103 "paraphrases language which has often been used in decisions of the courts, and the section has been added to the statute for uniformity and definiteness". Nothing suggested any change of standard.

[2] Reference is often made to a "return" from the standard of the Cuno and A. & P. cases to that of Hotchkiss v. Greenwood, an obvious impossibility since these cases apply the same standard as noted in the Cuno case.

[3] Hearings before the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary, United States Senate, 84th Cong., 1st Sess., pursuant to S. Res. 92 on the American Patent System, Oct. 11, 1955, pp. 119-120.

Since the *Lyon case*, the decisions have only added to the confusion. Petitioner submits that an authoritative consideration and interpretation of Section 103 by this Court is urgently needed.

(2) The Decision of the Court of Appeals Is Based on a Standard of Invention Different From and Conflicting With the Standards in Other Circuits.

In the absence of an authoritative ruling by this Court on the effect of Section 103, the Patent Act of 1952 has signally failed to accomplish one of the hoped-for objectives of Congress. As stated in the reports of the Judiciary Committees of both the Senate and the House, which accompanied the bill when it was presented and adopted, one of the "major changes" was the incorporation of "a requirement for invention in Sec. 103", which it was thought "should have a stabilizing effect and minimize great departures."[1]

Instead the new section has created confusion between the various Circuits by reason of the change that some, but not all, assume it to have worked in the rules previously established by the decisions of this Court as to the standard of invention required for patentability.

Some Circuits Follow the Lyon Decision in the Second Circuit

In June, 1955, Judges Learned Hand, Swan and Hincks handed down the decision of the Second Circuit Court of Appeals in the *Lyon case* mentioned above. As previously indicated (footnote [3], p. 6), Judge Hand apparently was in doubt as to the accuracy of the Court's view that the intent of Con-

[1] H.R. Rep. No. 1923, 82nd Cong., 2d Sess., pp. 5 and 7; S. Rep. No. 1979, 82nd Cong., 2d Sess., pp. 4 and 6.

gress in passing the new Act had been to change the rules as to the standard of invention, and as pointed out below there is still disagreement between the Judges of the Second Circuit Court of Appeals. Nevertheless Judge Hand's opinion has found favor and has been followed in a number of other Circuits.

The Third Circuit has liberally construed the Patent Act and specifically adopted the reasoning and holding of the *Lyon case*. In *R. M. Palmer Co.* v. *Ludeh's, Inc.*, 236 F. 2d 496, 498, 500, 501 (1956), six of the seven sitting judges affirmed the validity of certain design patents for simple objects, relying upon the statutory presumption of validity and accepting the argument that the Patent Act constituted "a congressional change of direction to assertedly more lenient criteria" than the previous rigid standard for determining validity. The Court said that it was inclined to accept the "sensitive observations of Judge Learned Hand" in the *Lyon case*. The *Palmer case* was followed by the Third Circuit in *Plax Corp.* v. *Precision Extruders, Inc.*, 239 F. 2d 792, 794-795 (1957), and *Fisch* v. *Gould*, 246 F. 2d 5, 7-8 (1957), cert. denied, 355 U.S. 914 (1958).

The Fourth Circuit Court of Appeals similarly has relaxed the rigid requirements for invention, following the *Lyon case*. In *Brown* v. *Brock*, 240 F. 2d 723, 726-728 (1957), the Court upheld a patent on a weeping doll, concluding that "The patent involved here certainly meets the standard of invention by the accepted tests, as recently explained in [the *Lyon case*]." And in *Otto* v. *Koppers Co.*, 246 F. 2d 789, 799-801 (1957), cert. denied, 355 U. S. 939 (1958), the same Court, holding that the factors of commercial success and long un-

successful attempts overcame the defense of obviousness, and, relying on the *Lyon case* and the statutory presumption of validity, reversed a judgment of invalidity.

The Court of Appeals for the District of Columbia, in *L-O-F Glass Fibers Co.* v. *Watson*, 228 F. 2d 40, 47 (1955), reversed a denial of a patent application and specifically adopted and followed the teaching of the Lyon case, saying:

> "* * * We may safely assume that the Patent Act of 1952, 35 U.S.C.A. Sec. 103 was intended to restore 'the law to what it was when the Court announced the definition of invention.' See discussion by Judge Learned Hand in Lyon v. Bausch & Lomb Optical Co. * * *."

The decision of the Fourth Circuit Court of Appeals in the present case, while it does not mention the *Lyon case* by name, is another instance of the application of the theory of the *Lyon case*, now well established in the Fourth Circuit.

Meanwhile, however, disagreement has made itself felt between the judges of the Second Circuit itself, as indicated by the division of the Court in *E. J. Brooks Co.* v. *Stoffel Seals Corp.*, 266 F. 2d 841. The situation is thoroughly discussed in the pending petition (No. 361) of Stoffel Seals Corp. for a writ of certiorari.

Other Circuits Continue to Follow the Rules As to Standard of Invention Established by Decisions of This Court Prior to the Patent Act of 1952

The view of the Circuits in this category is well illustrated by the following statement by the Eighth Circuit Court of Appeals in *Steffan* v. *Weber Heating and Sheet Metal Company*, 237 F. 2d 601, 604 (1956):

> "Plaintiffs contend that the Patent Act of 1952, and particularly 35 U.S.C. Sec. 103, has liberalized the test of invention to be applied. See Lyon v. Bausch & Lomb Optical Co., 2 Cir., 224 F. 2d 530. The effect, if any, of section 103 upon standards to be applied in determining validity of patents has not been passed upon by the Supreme Court."

The First and Ninth Circuits adhere to the same view. In the Ninth Circuit, in *Oriental Foods* v. *Chun King Sales*, 244 F. 2d 909 (1957), the Court first quoted Section 103, and then pointed out that the standard of invention was written into the Constitution and proceeded to apply Section 103 in the light of the *A. & P. case*.

In the First Circuit case of *Wasserman* v. *Burgess & Blacher*, 217 F. 2d 402 (1954), the Court stated that the Patent Act of 1952 "merely codified the existing decisional law." Subsequently, the *Lyon case* was called to the attention of the Court in *Hawley Products Co.* v. *United States Trunk Co.*, 259 F. 2d 69 (1958), but the Court did not find it necessary specifically to reject the *Lyon case* since the patents were invalid anyway. The later case of *Bernard Glagovsky* v. *Bowcroft Trimming Co.*, 267 F. 2d 479 (1959) is now pending before this Court on a petition by Glagovsky (No. 369) for a writ of certiorari. In this decision the Court of Appeals refused to review its finding in the Wasserman case, holding again that the patent was invalid even when judged by a liberal standard of invention.

This hopeless conflict of opinion and decision between the various Circuits can only be resolved by an authoritative decision from this Court as to the Congressional intent in passing the new act, and specifically as to the effect of Section No. 103 on the standard of invention.

CONCLUSION

Petitioner submits that this basic issue in an important branch of Federal law, i.e., the meaning and effect of the statutory requirement for patentable invention, should no longer be left to doubt but should be resolved once and for all by this Court, to provide the stabilization desired and intended by Congress, and to put an end to "forum shopping", and promote uniformity of decision throughout the various Circuits.

For each and all of the above reasons, this petition should be granted.

Respectfully submitted,

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